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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/510,095	12/08/2004	Kia Silverbrook	YUI88US	6890
24011	7590	11/09/2006	EXAMINER	
SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, NSW 2041 AUSTRALIA			SOLOMON, LISA	
			ART UNIT	PAPER NUMBER
			2861	

DATE MAILED: 11/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/510,095	<b>Applicant(s)</b> SILVERBROOK, KIA	
	<b>Examiner</b> Lisa M. Solomon	<b>Art Unit</b> 2861	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/05/04, 5/30/06</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Priority***

1. If applicant desires to claim the benefit of a prior-filed application under 35 U.S.C. 120, a specific reference to the prior-filed application in compliance with 37 CFR 1.78(a) must be included in the first sentence(s) of the specification following the title or in an application data sheet. For benefit claims under 35 U.S.C. 120, 121 or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications.

If the instant application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable

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petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 rejected under 35 U.S.C. 102(b) as being anticipated by Silverbrook (2001/0006394).

In re claim 1, *Silverbrook (2001/0006394)* teaches a printhead for an inkjet printer, the printhead comprising at least one printhead chip, said at least one printhead chip comprising a substrate (116, Fig. 17); and a plurality of nozzle arrangements (110, Fig. 17) positioned on the substrate (116), each nozzle arrangement (110) comprising nozzle chamber walls (132, 150, Fig. 18) and a roof wall (130, Fig. 18) that define a nozzle chamber (134, Fig. 18), the roof wall (130) defining at least one ink ejection port (124, Fig. 18); and an ink ejection mechanism (128, Fig. 18) that is operatively positioned with respect to the nozzle chamber (134) to eject ink from the at least one ink ejection port (124) on displacement of the ink ejection mechanism (128); and a nozzle guard (180, Fig. 23) that is positioned on the, or each respective, printhead chip, the nozzle guard (180) comprising a body member (182, Fig. 23) that is spaced from and spans the printhead chip, the body member (182) defining a plurality of passages (184, Fig. 23) that extend through the body member (182), the body member (182) being positioned so that each passage (184) is aligned with one of the ink ejection ports (124), a thickness of the body member (182) and a cross sectional area of each passage (184) being such that ink ejected from the ink ejection ports (124) can pass through the passages (184); and a support structure (186, Fig. 23) that is interposed between the body member (182) and the printhead chip, the support structure (186) being configured

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to permit the flow of air into a space defined between the body member (182) and the printhead chip and through each passage (184) to keep the passages (184) free of particles [Paragraphs 80-87, Paragraphs 95-100, See also Figs. 17-23].

In re claim 2, *Silverbrook (2001/0006394)* teaches a printhead as claimed in claim 1, in which the substrate (116) is in the form of a silicon wafer substrate [Paragraph 81 lines 1-2].

In re claim 3, *Silverbrook (2001/0006394)* teaches a printhead as claimed in claim 2, in which each nozzle arrangement (110) is the product of an integrated circuit fabrication process carried out on the silicon wafer substrate (116) so that the nozzle arrangement (110) defines a micro-electromechanical system [Paragraphs 101-123].

In re claim 4, *Silverbrook (2001/0006394)* teaches a printhead as claimed in claim 1, in which the support structure (186) is defined by a plurality of struts (186) that are interposed between the body member (182) and the printhead chip [Paragraphs 97-98].

### ***Double Patenting***

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-4 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-4 of prior U.S. Patent No. 6,588,886. This is a double patenting rejection.

Claims 1-4 of pending application 10/510,095
<p>1. A printhead for an ink jet printer, the printhead comprising at least one printhead chip, said at least one printhead chip comprising a substrate; and a plurality of nozzle arrangements positioned on the substrate, each nozzle arrangement comprising nozzle chamber walls and a roof wall that define a nozzle chamber, the roof wall defining at least one ink ejection port; and an ink ejection mechanism that is operatively positioned with respect to the nozzle chamber to eject ink from the at least one ink ejection port on displacement of the ink ejection mechanism; and a nozzle guard that is positioned on the, or each respective, printhead chip, the nozzle guard comprising a body member that is spaced from and spans the printhead chip, the body member defining a plurality of passages that extend through the body member, the body member being positioned so that each passage is aligned with one of the ink ejection ports, a thickness of the body member and a cross sectional area of each passage being such that ink ejected from the ink ejection ports can pass through the passages; and a support structure that is interposed between the body member and the printhead chip, the support structure being configured to permit the flow of air into a space defined between the body member and the printhead chip and through each passage to keep the passages clear of particles.</p>

2. A printhead as claimed in claim 1, in which the substrate is in the form of a silicon wafer substrate.

3. A printhead as claimed in claim 2, in which each nozzle arrangement is the product of an integrated circuit fabrication process carried out on the silicon wafer substrate so that the nozzle arrangement defines a micro-electromechanical system.

4. A printhead as claimed in claim 1, in which the support structure is defined by a plurality of struts that are interposed between the body member and the printhead chip.

Claims 1-4 of US Patent No. 6,588,886

1. A printhead for an ink jet printer, the printhead comprising at least one printhead chip, said at least one printhead chip comprising a substrate; and a plurality of nozzle arrangements positioned on the substrate, each nozzle arrangement comprising nozzle chamber walls and a roof wall that define a nozzle chamber, the roof wall defining at least one ink ejection port; and an ink ejection mechanism that is operatively positioned with respect to the nozzle chamber to eject ink from the at least one ink ejection port on displacement of the ink ejection mechanism; and a nozzle guard that is positioned on the, or each respective, printhead chip, the nozzle guard comprising a body member that is spaced from and spans the printhead chip, the body member defining a plurality of passages that extend through the body member, the body member being positioned so that each passage is aligned with one of the ink ejection ports, a thickness of the body member and a cross sectional area of each passage being such that ink ejected from the ink ejection ports can pass through the passages; and a support structure that is interposed between the body member and the printhead chip, the support structure being configured to permit the flow of air into a space defined between the body member and the printhead chip and through each passage to keep the passages clear of particles.

2. A printhead as claimed in claim 1, in which the substrate is in the form of a silicon wafer substrate.

3. A printhead as claimed in claim 2, in which each nozzle arrangement is the product of an integrated circuit fabrication process carried out on the silicon wafer substrate so that the nozzle arrangement defines a micro-electromechanical system.

4. A printhead as claimed in claim 1, in which the support structure is defined by a plurality of struts that are interposed between the body member and the printhead chip.

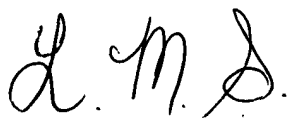


***Conclusion***

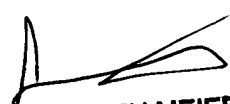
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa M. Solomon whose telephone number is (571) 272-1701. The examiner can normally be reached on 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Lisa M. Solomon  
Patent Examiner  
11/7/2006



STEPHEN MEIER  
SUPERVISORY PATENT EXAMINER